

This Opinion is Not a
Precedent of the TTAB

Mailed: August 15, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Spring Meadow Nursery, Inc.
v.
Plant Development Services, Inc.
—

Opposition No. 91252622

—
Brian D. Wassom of Warner Norcross + Judd LLP
for Spring Meadow Nursery, Inc.

Theodore A. Breiner of Breiner & Breiner, L.L.C.
for Plant Development Services, Inc.

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Before Wellington, Adlin and English, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Plant Development Services, Inc. seeks registration of JEWEL BOX, in standard characters, for “live plants, namely distylium” in International Class 31.¹

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¹ Application Serial No. 88567322, filed August 5, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on the mark’s first use in commerce on January 9, 2019. Applicant also owned another application previously involved in this proceeding (EMERALD BOX for the same goods, application Serial No. 88567359), but withdrew that application shortly after discovery opened. 11 and 12 TTABVUE. Citations to the record refer to TTABVUE, the Board’s online docketing system. Specifically, the number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

In its notice of opposition, Opposer Spring Meadow Nursery, Inc. alleges prior use and registration of the marks GEM BOX and JUKE BOX, both in standard characters, for “live plants.”² Opposer’s pleaded GEM BOX registration is more than five years old. As grounds for opposition, Opposer alleges that use of Applicant’s mark would be likely to cause confusion with Opposer’s marks.³ In its answer, Applicant denies the salient allegations in the notice of opposition.⁴

I. The Record and Evidentiary Objections

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s involved application. In addition, Opposer introduced:

Testimony declaration of Jeremy Deppe, its General Manager, and the exhibits thereto (“J. Deppe Dec.”). 30-33 and 35 TTABVUE.

Testimony declaration of Dale Deppe, its President (“D. Deppe Dec.”). 34 TTABVUE.

² Registration Nos. 4686050, issued February 10, 2015, and 5544173, issued August 21, 2018, respectively. Opposer’s Section 8 Affidavit for the GEM BOX registration has been accepted, and Opposer’s Section 15 Affidavit for that registration has been acknowledged.

³ While the notice of opposition also alleges, without further explanation, that Applicant’s mark “falsely suggest[s] a connection with Opposer and Opposer’s Marks,” 1 TTABVUE 7, the Electronic System for Trademark Trials and Appeals (“ESTTA”) coversheet for the pleading identifies likelihood of confusion as Opposer’s only claim. More importantly, the notice of opposition does not sufficiently state a claim for false suggestion. *Schiedmayer Celesta GmbH v. Piano Factory Grp., Inc.*, 2019 USPQ2d 341894, at *6 (TTAB 2019), *aff’d*, 11 F.4th 1363 (Fed. Cir. 2021) (setting forth elements of a false suggestion claim). In any event, Opposer did not pursue a false suggestion claim at trial, or argue false suggestion in its Trial Brief, so even if the claim was pleaded, it has been waived. *Alcatraz Media, Inc. v. Chesapeake Marine Tour Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013), *aff’d* 565 F. App’x 900 (Fed. Cir. 2014).

⁴ Applicant also raised purported “affirmative defenses” that merely amplify its denials, question Opposer’s entitlement to a statutory cause of action (which is an element of Opposer’s case) or improperly reserve “the right to assert additional affirmative defenses.”

First Rebuttal Notice of Reliance on Applicant's discovery responses ("Reb. NOR 1"). 56 TTABVUE.

Second Rebuttal NOR on Internet printouts and official records ("Reb. NOR 2"). 57 TTABVUE.

Applicant introduced:

Testimony declaration of Kip McConnell, its Vice-President of Business Development ("McConnell Dec."). 41 TTABVUE.

Testimony declaration of Gregory L. Smith, Jr., its President ("Smith Dec."). 42 TTABVUE.

Testimony declaration of Kevin Northrop, its Vice-President of Marketing ("Northrup Dec."). 43 TTABVUE.

Testimony declaration of Carl E. Jennison, a practicing trademark attorney and Applicant's expert witness (Jennison Dec."). 44 TTABVUE.

First NOR on Opposer's initial and pretrial disclosures and discovery responses ("App. NOR 1"). 45 and 51 TTABVUE.

Second NOR on printed publications and Internet printouts ("App. NOR 2"). 46, 51, 52 and 55 TTABVUE.

Third NOR on official records and Internet printouts ("App. NOR 3"). 47 and 52-55 TTABVUE.⁵

Fourth NOR on official records ("App. NOR 4"). 48 and 51-55 TTABVUE.

Fifth NOR on Internet printouts ("App. NOR 5"). 49 and 55 TTABVUE.

⁵ For the most part, we have not considered Exhibits 64 and 65 submitted with this NOR, because produced documents may not be introduced by NOR alone. Trademark Rule 2.120(k)(3)(ii). We have, however, considered the official records Opposer produced which are included with these exhibits because they are otherwise admissible under Trademark Rule 2.122(e). *Id.*

Applicant objects to “the headings in the [J. Deppe Dec.] as they are not testimony.” 61 TTABVUE 50. This objection, the point of which is not understood, is overruled. Each heading accurately describes the testimony that follows and Mr. Deppe’s execution of the declaration including the headings reveals that Mr. Deppe views the headings as accurate. Moreover, Mr. Deppe’s execution of the declaration reveals that contrary to Applicant’s bald assertion, the headings are part of Mr. Deppe’s testimony.⁶

Applicant’s next objection, *id.*, appears to be that Opposer mistakenly included a single page depicting Applicant’s JEWEL BOX product in a 163 page exhibit that otherwise depicts Opposer’s products and promotional materials. 35 TTABVUE 10. The objection is overruled, but obviously we have not considered the document because it is not supported by Mr. Deppe’s accompanying testimony. Applicant’s similarly non-substantive “objection” to obvious typographical errors in the Table of Contents to, and a heading in, Opposer’s Trial Brief, 61 TTABVUE 50, are overruled because these are obvious typos.⁷

Applicant’s objections to Paragraphs 32-34 of the J. Deppe Dec. and Paragraphs 11-13 of the D. Deppe Dec. on the ground that they contain “speculation,” lack foundation or are not supported by “personal knowledge,” 61 TTABVUE 50-53, are moot. The Board is able to distinguish facts based on personal knowledge (which are

⁶ Objections that, even if sustained, would not materially affect the record before us are unhelpful to the party making them (and the Board).

⁷ Applicant not so subtly characterizes these obvious typos as intentional “misstatements,” asserting that they are “beneath opposer.” 61 TTABVUE 50. Opposer’s brief as a whole belies the characterization.

considered) from speculation (which is not), and summaries of general “experience” (which has minimal probative value, if any) from testimony about specific facts (which is generally more probative).

II. Relevant Facts

The parties are competitors in the market for live plants, and more specifically plant liners. Plant liners are also known as “rooted cuttings.” 43 TTABVUE 5 (Northrop Dec. ¶ 12). As Applicant claims in its Trial Brief and Opposer does not dispute, “[a] ‘liner’ is a young plant that will be re-potted into a larger container and grown into a mature plant for wholesale or retail sale.” 61 TTABVUE 13 n.2.

A. Opposer

Dale and Liz Deppe founded Opposer in 1981. 30 TTABVUE 2-3 (J. Deppe Dec. ¶ 5). “What started as a small, primarily contract-growing operation has grown to become one of the largest and best-known woody plant liner providers in North America.” *Id.*

Opposer now offers over 400 varieties of plants, most or all of which are identified by trademarks, as shown below:

2015-2016 Spring Meadow Nursery Flowering Shrub Price List													800-633-8859			
 Proven Winners® ColorChoice®		2 1/2"				4"				Quick Turn				Royalty & MFR Fee		
Item #		1024	512	96	32	Item #	2008	504	54	18	Item #	1024	512		96	16
BRONZE ANNIVERSARY™ <i>Abelia</i>	00592	\$1.89	\$1.99	\$2.04	\$2.21	00594	\$2.49	\$2.59	\$2.64	\$2.81	00595	\$3.09	\$3.19	\$3.24	\$3.41	\$0.75
RUBY ANNIVERSARY™ <i>Abelia</i>	00122	\$1.89	\$1.99	\$2.04	\$2.21	00124	\$2.49	\$2.59	\$2.64	\$2.81	00125	\$3.09	\$3.19	\$3.24	\$3.41	\$0.75
SUNNY ANNIVERSARY™ <i>Abelia</i>	00322	\$1.89	\$1.99	\$2.04	\$2.21	00324	\$2.49	\$2.59	\$2.64	\$2.81	00325	\$3.09	\$3.19	\$3.24	\$3.41	\$1.00
PINKY BELLS™ <i>Abelia</i>	00622	\$1.89	\$1.99	\$2.04	\$2.21	00624	\$2.49	\$2.59	\$2.64	\$2.81	00625	\$3.09	\$3.19	\$3.24	\$3.41	\$0.75
SWEET EMOTION™ <i>Abelia</i>	00572	\$1.89	\$1.99	\$2.04	\$2.21	00574	\$2.49	\$2.59	\$2.64	\$2.81	00575	\$3.09	\$3.19	\$3.24	\$3.41	\$0.85
LOW SCAPE™ <i>Hedger Aronia</i>	02832	\$2.04	\$2.14	\$2.19	\$2.36	02834	\$2.64	\$2.74	\$2.79	\$2.96	02835	\$3.24	\$3.34	\$3.39	\$3.56	\$1.10
LOW SCAPE™ <i>Mound Aronia</i>	02822	\$2.04	\$2.14	\$2.19	\$2.36	02824	\$2.64	\$2.74	\$2.79	\$2.96	02825	\$3.24	\$3.34	\$3.39	\$3.56	\$1.10
SUNJOY™ <i>Cinnamon Berberis</i>	03052	\$2.04	\$2.14	\$2.19	\$2.36	03054	\$2.64	\$2.74	\$2.79	\$2.96	03055	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
SUNJOY™ <i>Citrus Berberis</i>	03252	\$2.04	\$2.14	\$2.19	\$2.36	03254	\$2.64	\$2.74	\$2.79	\$2.96	03255	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
SUNJOY™ <i>Gold Beret Berberis</i>	04132	\$2.04	\$2.14	\$2.19	\$2.36	04134	\$2.64	\$2.74	\$2.79	\$2.96	04135	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
SUNJOY™ <i>Gold Pillar Berberis</i>	03872	\$2.04	\$2.14	\$2.19	\$2.36	03874	\$2.64	\$2.74	\$2.79	\$2.96	03875	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
SUNJOY™ <i>Mini Saffron Berberis</i>	03242	\$2.04	\$2.14	\$2.19	\$2.36	03244	\$2.64	\$2.74	\$2.79	\$2.96	03245	\$3.24	\$3.34	\$3.39	\$3.56	\$0.75
SUNJOY™ <i>Mini Salsa Berberis</i>	03342	\$2.04	\$2.14	\$2.19	\$2.36	03344	\$2.64	\$2.74	\$2.79	\$2.96	03345	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
SUNJOY™ <i>Syrah Berberis</i>	03192	\$2.04	\$2.14	\$2.19	\$2.36	03194	\$2.64	\$2.74	\$2.79	\$2.96	03195	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
SUNJOY™ <i>Tangelo Berberis</i>	03862	\$2.04	\$2.14	\$2.19	\$2.36	03864	\$2.64	\$2.74	\$2.79	\$2.96	03865	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
<i>Betula 'Golden Treasure'</i>	04442	\$2.19	\$2.29	\$2.34	\$2.51	04444	\$2.79	\$2.89	\$2.94	\$3.11	04445	\$3.39	\$3.49	\$3.54	\$3.71	\$1.05
ADONIS BLUE™ <i>Buddleia</i>	-	-	-	-	-	04674	\$1.95	\$2.05	\$2.10	\$2.27	04675	\$2.55	\$2.65	\$2.70	\$2.87	\$0.75
PEACOCK™ <i>Buddleia</i>	-	-	-	-	-	04654	\$1.95	\$2.05	\$2.10	\$2.27	04655	\$2.55	\$2.65	\$2.70	\$2.87	\$0.75
PURPLE EMPEROR™ <i>Buddleia</i>	-	-	-	-	-	04664	\$1.95	\$2.05	\$2.10	\$2.27	04665	\$2.55	\$2.65	\$2.70	\$2.87	\$0.75
INSPIRED PINK™ <i>Buddleia</i>	-	-	-	-	-	07124	\$2.24	\$2.34	\$2.39	\$2.56	07125	\$2.84	\$2.94	\$2.99	\$3.16	\$0.90
INSPIRED™ <i>Violet Buddleia</i>	-	-	-	-	-	07274	\$2.24	\$2.34	\$2.39	\$2.56	07275	\$2.84	\$2.94	\$2.99	\$3.16	\$0.90
INSPIRED™ <i>White Buddleia</i>	-	-	-	-	-	07264	\$2.24	\$2.34	\$2.39	\$2.56	07265	\$2.84	\$2.94	\$2.99	\$3.16	\$0.90
LO & BEHOLD™ <i>'Blue Chip' Buddleia</i>	07092	\$1.79	\$1.89	\$1.94	\$2.11	07094	\$2.39	\$2.49	\$2.54	\$2.71	07095	\$2.99	\$3.09	\$3.14	\$3.31	\$1.15
LO & BEHOLD™ <i>'Blue Chip Jr.' Buddleia</i>	04632	\$1.79	\$1.89	\$1.94	\$2.11	04634	\$2.39	\$2.49	\$2.54	\$2.71	04635	\$2.99	\$3.09	\$3.14	\$3.31	\$1.15
LO & BEHOLD™ <i>'Ice Chip' Buddleia</i>	04612	\$1.79	\$1.89	\$1.94	\$2.11	04614	\$2.39	\$2.49	\$2.54	\$2.71	04615	\$2.99	\$3.09	\$3.14	\$3.31	\$1.15
LO & BEHOLD™ <i>'Lilac Chip' Buddleia</i>	04602	\$1.79	\$1.89	\$1.94	\$2.11	04604	\$2.39	\$2.49	\$2.54	\$2.71	04605	\$2.99	\$3.09	\$3.14	\$3.31	\$1.15
LO & BEHOLD™ <i>'Pink Micro Chip' Buddleia</i>	05872	\$1.79	\$1.89	\$1.94	\$2.11	05874	\$2.39	\$2.49	\$2.54	\$2.71	05875	\$2.99	\$3.09	\$3.14	\$3.31	\$1.15
LO & BEHOLD™ <i>'Purple Haze' Buddleia</i>	-	-	-	-	-	04554	\$2.39	\$2.49	\$2.54	\$2.71	04555	\$2.99	\$3.09	\$3.14	\$3.31	\$1.15
<i>Buddleia 'Miss Molly'</i>	04532	\$1.69	\$1.79	\$1.84	\$2.01	04534	\$2.29	\$2.39	\$2.44	\$2.61	04535	\$2.89	\$2.99	\$3.04	\$3.21	\$1.00
<i>Buddleia 'Miss Pearl'</i>	06722	\$1.69	\$1.79	\$1.84	\$2.01	06724	\$2.29	\$2.39	\$2.44	\$2.61	06725	\$2.89	\$2.99	\$3.04	\$3.21	\$1.00
<i>Buddleia 'Miss Ruby'</i>	07042	\$1.69	\$1.79	\$1.84	\$2.01	07044	\$2.29	\$2.39	\$2.44	\$2.61	07045	\$2.89	\$2.99	\$3.04	\$3.21	\$1.00
<i>Buddleia 'Miss Violet'</i>	05842	\$1.69	\$1.79	\$1.84	\$2.01	05844	\$2.29	\$2.39	\$2.44	\$2.61	05845	\$2.89	\$2.99	\$3.04	\$3.21	\$1.00
<i>Buddleia 'Summer Skies'</i>	-	-	-	-	-	06464	\$2.24	\$2.34	\$2.39	\$2.56	06465	\$2.84	\$2.94	\$2.99	\$3.16	\$0.90
NORTH STAR™ <i>Buxus</i>	07722	\$2.04	\$2.14	\$2.19	\$2.36	07724	\$2.64	\$2.74	\$2.79	\$2.96	07725	\$3.24	\$3.34	\$3.39	\$3.56	\$0.75
SPRINTER™ <i>Buxus</i>	07442	\$2.04	\$2.14	\$2.19	\$2.36	07444	\$2.64	\$2.74	\$2.79	\$2.96	07445	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
WEDDING RING™ <i>Buxus</i>	07612	\$2.19	\$2.29	\$2.34	\$2.51	07614	\$2.79	\$2.89	\$2.94	\$3.11	07615	\$3.39	\$3.49	\$3.54	\$3.71	\$0.85
PEARL GLAM™ <i>Callicarpa</i>	08162	\$1.89	\$1.99	\$2.04	\$2.21	08164	\$2.49	\$2.59	\$2.64	\$2.81	08165	\$3.09	\$3.19	\$3.24	\$3.41	\$0.85
PURPLE PEARLS™ <i>Callicarpa</i>	08302	\$1.89	\$1.99	\$2.04	\$2.21	08304	\$2.49	\$2.59	\$2.64	\$2.81	08305	\$3.09	\$3.19	\$3.24	\$3.41	\$0.75
<i>Calycanthus 'Aphrodite'</i>	-	-	-	-	-	08364	\$3.04	\$3.14	\$3.19	\$3.36	08365	\$4.24	\$4.34	\$4.39	\$4.56	\$1.05
BEYOND MIDNIGHT™ <i>Caryopteris</i>	08722	\$2.04	\$2.14	\$2.19	\$2.36	08724	\$2.64	\$2.74	\$2.79	\$2.96	08725	\$3.24	\$3.34	\$3.39	\$3.56	\$1.00
LIL' MISS SUNSHINE™ <i>Caryopteris</i>	08412	\$2.04	\$2.14	\$2.19	\$2.36	08414	\$2.64	\$2.74	\$2.79	\$2.96	08415	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
PETIT BLEU™ <i>Caryopteris</i>	08692	\$2.04	\$2.14	\$2.19	\$2.36	08694	\$2.64	\$2.74	\$2.79	\$2.96	08695	\$3.24	\$3.34	\$3.39	\$3.56	\$0.75
SUNSHINE BLUE™ II <i>Caryopteris</i>	08552	\$2.04	\$2.14	\$2.19	\$2.36	08554	\$2.64	\$2.74	\$2.79	\$2.96	08555	\$3.24	\$3.34	\$3.39	\$3.56	\$0.85
MARIE BLEU™ <i>Ceanothus</i>	09012	\$2.04	\$2.14	\$2.19	\$2.36	09014	\$2.64	\$2.74	\$2.79	\$2.96	09015	\$3.24	\$3.34	\$3.39	\$3.56	\$0.75
MARIE GOLD™ <i>Ceanothus</i>	08922	\$2.04	\$2.14	\$2.19	\$2.36	08924	\$2.64	\$2.74	\$2.79	\$2.96	08925	\$3.24	\$3.34	\$3.39	\$3.56	\$0.75

31 TTABVUE 6 (J. Deppe Dec. Ex. 18.1).

Opposer has used its GEM BOX mark since 2014 for an inkberry holly, shown below on the left, and its JUKE BOX mark since 2017 for a dwarf broadleaf evergreen, shown below on the right:



Id. at 3-5 (J. Deppe. Dec. ¶¶ 8-13). Opposer markets each plant as a “boxwood alternative.” *Id.* Boxwoods are “slow growing evergreen shrubs and small trees,” and “have long been one of the most popular decorative landscaping plants in many regions across the country,” but in the last decade they “have been severely impacted by the fungal ‘boxwood blight’ disease.” *Id.* at 8 (J. Deppe ¶ 20).

“That explains why each mark includes the word ‘BOX’; it is meant to connote the plant’s ability to supplant boxwoods, not to identify them as boxwoods.” *Id.* at 9 (J. Deppe ¶ 21); *see also* 52 TTABVUE 65, (Opposer’s responses to Requests for Admission Nos. 30-32 and Interrogatory No. 20) (“Opposer’s use of the word BOX in its asserted marks is intended to be suggestive of the fact that the plant may be used as a boxwood alternative ...”). In fact, Opposer offers a “Box Series’ line of plants,” including its STRONGBOX, SKY BOX and PATTI-O-BOX plants. 30 TTABVUE 9 (J. Deppe ¶ 21).⁸

⁸ Opposer has not pled, and does not argue, that it owns a “family” of BOX marks.

Opposer “advertises its plants in brochures, on its website and through the websites of affiliated companies, and sells them to various independent nurseries and retailers who grow and sell the plants to end users who are mostly landscapers, homeowners, and other individual consumers.” *Id.* at 8 (J. Deppe ¶ 19). Opposer’s GEM BOX and JUKE BOX plants “are generally sold to end users at price points between \$20-\$40 at mass merchants and between \$20-\$50 at independent garden centers.” *Id.* at 11 (J. Deppe Dec. 33).

B. Applicant

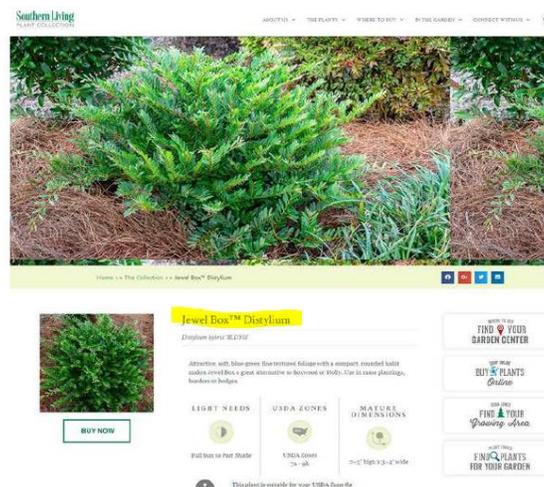
Gregory L. Smith, Jr. founded Applicant in 1996. Mr. Smith is a member of the Smith family that founded and operates Flowerwood Nursery, Inc., a commercial wholesale grower and nursery and “one of the largest producers of shrubs and woody ornamentals in the southeast.” 41 TTABVUE 3 (McConnell Dec. ¶ 5).

Applicant develops “new and improved plant varieties” and markets them “to nursery growers throughout the U.S. for large-scale production and sale to retail consumers.” *Id.* at 4 (McConnell Dec. ¶ 6). “Today, [Applicant] owns or licenses the U.S. plant patents (or pending applications for U.S. plant patents) to over 200 plant varieties, and markets and sells these plants, together with other plant varieties, under one or more of its three nationally recognized plant brands, namely, SOUTHERN LIVING® Plant Collection ENCORE® Azalea, and SUNSET WESTERN GARDEN COLLECTION®.” *Id.* Like Opposer, Applicant owns hundreds of trademarks “under which it sells its Branded Plants.” *Id.* (McConnell Dec. ¶ 7).

Applicant “promotes the Brands and Branded Plants through a variety of media channels including print publications, brochures, point of sale advertising, live

promotional events, social media, and e-mail marketing,” and “showcases its Branded Plants at numerous trade shows, plant exhibitions, horticultural events, and community outreach events across the U.S. each year.” *Id.* (McConnell Dec. ¶ 8). Applicant “licenses the Brands and the Branded Plants to over 80 nursery growers, including Flowerwood, who are licensed to propagate, grow, and sell the plants, and to over 200 non-propagating nurseries who purchase liners from [Applicant] and are licensed to grow the liners and sell the mature plants.” *Id.* at 5 (McConnell Dec. ¶ 9). Applicant’s “licensees sell finished plants to retail and re-wholesale customers including mass merchant garden centers, independent garden centers, landscape professionals, and re-wholesale nurseries.” *Id.*

Just as Opposer markets its GEM BOX and JUKE BOX plants as boxwood “alternatives,” Applicant “markets and promotes JEWEL BOX distylium as a boxwood alternative.” *Id.* at 7 (McConnell Dec. ¶ 16). While distylium is obviously different than Opposer’s GEM BOX inkberry holly and JUKE BOX dwarf broadleaf evergreen, in some ways it appears similar to and has some characteristics in common with those plants:



Id. Like Opposer, Applicant “selected the trademark JEWEL BOX using the word ‘box’ to describe or suggest that it is an alternative to the boxwood in the landscape.”

Id. at 8 (McConnell Dec. ¶ 16).

III. Opposer’s Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020), *cert. denied*, 142 S.Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)).

A party in the position of plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

Here, Opposer’s pleaded registrations, 1 TTABVUE 9-14, and prior use of its pleaded marks, 30 TTABVUE 3-6 (J. Deppe Dec. ¶¶ 8-16), establish that it is entitled to oppose registration of Applicant’s mark on the ground of likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (registration establishes “standing”); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*,

90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark “is sufficient to support opposer’s allegations of a reasonable belief that it would be damaged ...” where opposer alleged likelihood of confusion).

IV. Priority

Because Applicant has not counterclaimed to cancel either of Opposer’s pleaded registrations, priority is not at issue with respect to the marks and goods identified therein. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). In addition, Opposer has established prior common law use of its pleaded marks for live plants, specifically use of GEM BOX since 2014 for inkberry holly and use of JUKE BOX since 2017 for dwarf broadleaf evergreen. 30 TTABVUE 3-6 (J. Deppe Dec. ¶¶ 8-16). Applicant did not use or apply for registration of its involved JEWEL BOX mark until 2019. 41 TTABVUE 8 (McConnell Dec. ¶¶ 17, 19).

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

We focus our analysis on Opposer's pleaded GEM BOX mark. If we find confusion likely between that pleaded mark and Applicant's involved mark, we need not consider the likelihood of confusion between Applicant's mark and Opposer's other pleaded mark. On the other hand, if we find no likelihood of confusion between the GEM BOX mark and Applicant's mark, we would not find confusion likely between Applicant's mark and Opposer's pleaded JUKE BOX mark. *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The Goods, Channels of Trade and Classes of Consumers

The parties' goods are legally identical because Opposer's pleaded GEM BOX mark is registered for "live plants," which is broad enough to encompass the "live plants, namely, distylium" identified in the involved application. Moreover, because the goods are legally identical, we presume that the channels of trade and classes of purchasers for these goods also overlap. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

The legal identity of the goods and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 Fed Cir. 2010); *In re Max Capital*, 93 USPQ2d at 1248.

B. The Strength of Opposer’s GEM BOX Mark

Before addressing the marks themselves, we consider the strength of Opposer’s mark, to ascertain the scope of protection to which it is entitled. There are two types of strength: conceptual and commercial. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength ...”).

1. Conceptual Strength

Turning first to conceptual strength, because Opposer’s pleaded mark is registered on the Principal Register with no claim of acquired distinctiveness, and Applicant has not petitioned to cancel the registration on the ground of descriptiveness,⁹ we must presume that Opposer’s pleaded mark is inherently distinctive, i.e. that it is at worst suggestive of Opposer’s goods. 15 U.S.C. § 1057(b) (registration is “prima facie evidence of the validity of the registered mark”); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when mark is registered on the Principal Register, “we must assume that it is at least suggestive”). *See also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997)). While

⁹ In fact, because Opposer’s GEM BOX registration is more than five years old it may not be cancelled on the ground of descriptiveness. 15 U.S.C. § 1064.

the mark is inherently distinctive, and thus entitled to protection against confusingly similar marks, the record makes clear, and the parties effectively agree, that GEM BOX is fairly suggestive, and thus conceptually somewhat weak, because it suggests that Opposer’s live plants are alternatives to boxwoods, which are sometimes referred to simply as “boxes.” 59 TTABVUE 20-21 (conceding that Opposer intended the term BOX to suggest “that Opposer’s plants are suitable replacements for boxwoods”); 61 TTABVUE 35-36 (summarizing Applicant’s conclusion that Opposer’s GEM BOX mark is “suggestive”).

Moreover, Applicant has introduced evidence that several third-party marks containing BOX or GEM are registered for live plants:

<u>Mark/Reg. No.</u>	<u>Goods</u>
9GREENBOX Reg. No. 5497003	live plants; potted dwarfed trees (bonsai); potted live miniature succulents and cactus
SOFTBOX Reg. No. 5586762	living trees
 Reg. No. 6106103	live succulent plants; potted live miniature succulents and cactus
JAZZED GEMS Reg. No. 6197972	living ornamental plants, flowers, and cuttings thereof
AUSTRAL GEM Reg. No. 5951582	live plants, namely, ferns
FLEMING’S ROYAL GEMS Reg. No. 5824718	live plants

<u>Mark/Reg. No.</u>	<u>Goods</u>
 Reg. No. 5122067	natural plants and flowers, all excluding chrysanthemum flowers
DESERT GEMS Reg. No. 4645744	live flowers and living plants
BLACK GEM Reg. No. 2833183	live trees

55 TTABVUE 306, 387, 390, 393-94, 396; 51 TTABVUE 275, 280. Sometimes, third-party registrations may function as a dictionary, by showing “the sense in which a mark is used in ordinary parlance.” *Juice Generation, Inc. v. GS Enter., LLC*, 794 F.2d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015).

Here, we have already found that BOX is suggestive of certain types of live plants.¹⁰ As for GEM/GEMS, the evidence of only six third-party registrations is far from overwhelming, but it hints that the term may have some meaning in connection with live plants. Furthermore, we take judicial notice that a “gem” is a “jewel,” a “precious or sometimes semiprecious stone cut and polished for ornament,” or

¹⁰ Assuming Ozbreed uses its GREY BOX and AUSSIE BOX marks in the United States, 41 TTABVUE 10 (McConnell Dec. ¶ 22), those uses and other third-party uses of BOX for boxwood alternatives further establish the term’s suggestiveness.

“something prized especially for great beauty or perfection.”¹¹ The term GEM may thus suggest a quality or the appearance of Opposer’s live plants.

Thus, we conclude that while GEM BOX is inherently distinctive, it is somewhat suggestive, and therefore entitled to a narrower scope of protection than an arbitrary mark.

2. Commercial Strength

As for commercial strength, Opposer’s evidence falls short of establishing that GEM BOX is entitled to any more than an average scope of protection. Indeed, Opposer’s confidential sales and advertising figures are underwhelming. 30 TTABVUE 8, 9; 32 TTABVUE 3; 33 TTABVUE 32 (J. Deppe Dec. ¶¶ 18, 24 and Exs. 10, 16). Similarly, while Opposer or its marks have enjoyed modest media attention, there is no evidence quantifying the extent of consumer exposure to these publications, and nothing in the record which indicates that a significant portion of the consuming public has been exposed to Opposer’s GEM BOX mark or the live plants sold thereunder. 35 TTABVUE 167-214.

While Opposer has been successful in convincing several competitors to withdraw or amend applications to register marks which contain the word BOX and are used for plants, 30 TTABVUE 6-8, 19-154 (J. Deppe Dec. ¶ 17 and Exs. 3-9), neither the

¹¹ merriam-webster.com/dictionary/gem. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

nature of these efforts and agreements, nor their quantity, establishes that GEM BOX is commercially strong. *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, at * 20 (TTAB 2019) (“we find that competitors likely acquiesced to Freud’s assertion of its exclusive right to use the color red on saw blades to avoid litigation”); *cf. In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7, 8 n.2 (CCPA 1977) (“we agree with the TTAB that such evidence shows a desire of competitors to avoid litigation rather than distinctiveness of the mark”).

At the same time, Applicant’s efforts to establish that “there are a number of similar marks for similar goods,” 61 TTABVUE 39-42, fall short. In fact, Applicant attempts to support this argument with nothing more than third-party registrations for marks containing BOX or GEM/GEMS. *Id.*; 55 TTABVUE 306-324, 387-396; 51 TTABVUE 280, 286, 291. However, “third-party registrations are not evidence of third-party use of the registered marks in the marketplace, for purposes of the sixth *du Pont* factor.” *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (citing *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). *See also AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (“The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.”). Moreover, the quantity of third-party registrations Applicant cites pales in comparison to the number in, for example, *Jack*

Wolfskin Ausrüstung Fur Draussen, GmbH & Co. KGAA v. New Millennium Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

3. Conclusion Regarding Strength

While there is no evidence that Opposer's pleaded GEM BOX mark is commercially weak, it is entitled to a reduced scope of protection because it is conceptually somewhat weak. At the same time, as we compare the parties' marks, we must keep in mind that Opposer's GEM BOX mark is inherently distinctive, and that "likelihood of confusion, mistake or deception is to be avoided as much between weak marks as between strong marks." *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) (citing *King Candy*, 182 USPQ at 109).¹²

¹² Applicant contends that GEM is "not arbitrary or fanciful," because it is "commonly used in trademarks as apparent from a TESS search" showing "over 4,000 marks using 'Gem'" 61 TTABVUE 28. The "over 4,000" GEM marks Applicant refers to are not of record, nor are they relevant because Applicant has not shown that they are used for live plants. *See Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-95 (Fed. Cir. 2018); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017) ("Symbolic has not pointed to any record evidence to support a finding that multiple third parties use the mark I AM for the listed goods in its class 3 and 9 applications."); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("The relevant *du Pont* inquiry is '[t]he number and nature of similar marks in use on *similar goods*' ... It is less relevant that 'Century is used on unrelated goods or services such as 'Century Dental Centers' or 'Century Seafoods.'" (quoting *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990)); *In re Inn at St. Johns, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018). Moreover, while Applicant relies upon a small number of third-party marks containing GEM or BOX that are used or registered for cut or arranged flowers, fruit or vegetables, i.e. goods which come from plants, the industry and Opposer apparently treat these types of goods – which are not "live" in the sense that plant liners are – differently than the types of "live plants" Opposer and Applicant offer under their pleaded and involved marks. Indeed, Opposer does not enforce its pleaded marks against marks used for these types of goods. 30 TTABVUE 6-8, 19-154 (J. Deppe. ¶ 17 and Exs. 3-9) (showing the removal of "live plants" from third party applications' identifications of goods at Opposer's request, but that Opposer does not object to use of these third-party marks for wreaths, cut flowers or flower arrangements).

C. The Marks

The marks are more similar than dissimilar in “appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). In fact, the marks’ similarities in meaning, commercial impression, structure, cadence and sound outweigh the differences between them.

The most striking similarity between the marks is their essentially identical meanings and commercial impressions. Indeed, as indicated above, the first definition of “gem” is “jewel.” Thus, both marks convey and create the commercial impression of a box for storing jewels or gems, or a boxwood plant in the shape or with other characteristics of jewels or gems. It is settled that similarity in connotation or commercial impression alone “may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

For example, in *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), the Federal Circuit reversed the Board’s finding that confusion was unlikely between FUNDOUGH and PLAY-DOH for essentially identical goods, in part based on the marks’ “very similar impression.” *Id.* at 1457. Analogously, we regularly find a likelihood of confusion in doctrine of foreign equivalents cases based on similarity in meaning and commercial impression, even where the marks look and sound completely different. *See e.g. In re Aquamar, Inc.*, 115 USPQ2d 1122, 1128 (TTAB 2015) (finding BLUE SEA and MARAZUL

confusingly similar for identical goods, based in large part on similarity of meaning and commercial impression, citing cases).

Here, the marks do not just convey similar or identical meanings and create similar or identical commercial impressions. They also look and sound similar in important ways – they each consist of two words, with the first words being synonyms for each other that begin with a “j” sound, and the second words being identical.

We have kept in mind that Opposer’s GEM BOX mark is conceptually somewhat weak, but balance this against the more important fact that the parties’ goods are legally identical, which reduces the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 94 USPQ2d at 1260; *In re Max Capital*, 93 USPQ2d at 1248. In fact, likelihood of confusion “is to be avoided as much between weak marks as between strong marks.” *In re Colonial Stores*, 216 USPQ at 795.¹³

D. Consumer Sophistication and Care

Applicant contends on the one hand that “the growers of the plants, the mass merchant garden centers, the independent garden centers and the landscape professionals will not be confused as they are sophisticated purchasers.” 61 TTABVUE 32-33. However, Applicant recognizes on the other hand that “the

¹³ Applicant’s argument that Opposer “should not be able to monopolize the word ‘box’ to describe or suggest a boxwood alternative,” 61 TTABVUE 26, is not well-taken. That is not what Opposer is doing in this case. Rather, as explained above, Opposer is challenging an application to register a mark which has much more in common with its own than simply the word “box.”

purchasers of the plants for consideration herein are the retail consumers who purchase the plants from nurseries or garden centers.” *Id.*

There is no evidence that these “retail consumers” are sophisticated or that they will exercise particular care in purchasing live plants generally, or boxwood alternatives specifically. Applicant is correct to focus its attention on “retail consumers,” because we must base our decision on the “least sophisticated potential purchasers” for the goods as identified, such as consumers with no gardening or landscaping experience who may buy a single plant for \$36.98, *id.*, as a replacement for another, or for a small space in a yard or garden. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-63 (Fed. Cir. 2014).

Applicant argues that the least sophisticated retail consumers will exercise care in purchasing because a website through which the plants are sold “envisions consumers purchasing up to 500 plants for large-scale landscaping of beds, borders, or hedges.” 61 TTABVUE 32-33. Applicant’s argument is belied by the website it is apparently based on, which shows that consumers may buy a single plant for \$36.98, or receive discounts of 5%, 7% or 10% when they buy in quantities of 2-5, 6-13, or 14-500, respectively. *Id.* The website by default adds a single JEWEL BOX distylium plant to a consumer’s “shopping cart,” and the customer must change the quantity if more than one plant is purchased. *Id.*

Applicant’s speculation that consumers “**must** know the conditions of the landscape area, including the nature of the soil, the number of hours of daily sun, the year-round temperature range, the amount of water available or rainfall anticipated,”

and “the characteristics and requirements of the plant, including its growth rate and ultimate size, fertilizer requirements, pruning requirements, susceptibility to pests and disease, and whether the landscape area conditions are suitable for the plant to thrive,” 61 TTABVUE 34 (emphasis added), is unsupported by any evidence and is therefore not persuasive. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (“Attorney argument is no substitute for evidence.”) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); *see also In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014) (finding that there was no proof to support the statements in the record by counsel). The argument is also belied by the website Applicant primarily relies upon, 61 TTABVUE 33, which imposes no such requirements on purchasers, much less the “least sophisticated” purchasers of live plants.

E. Absence of Actual Confusion

Applicant “is not aware of any actual confusion between the JEWEL BOX distylium plants and the GEM BOX and JUKE BOX plants since the introduction of the JEWEL BOX distylium” slightly less than three years before trial. 41 TTABVUE 13 (McConnell Dec. ¶31). This testimony is not particularly probative, because while the record reveals that the parties’ goods are sold to and by the same types of retail outlets, such as garden centers and nurseries, Applicant’s mark had been in use for less than three years at the time of trial, and there is no evidence that any specific retailers or wholesalers offer both Applicant’s JEWEL BOX and Opposer’s GEM BOX plants in the same stores.

In fact, “the absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks.” *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Here, we cannot gauge from Applicant’s evidence whether or the extent to which there has been a meaningful opportunity for confusion to occur. *See also Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (“The absence of any showing of actual confusion is of very little, if any, probative value here because (1) no evidence was presented as to the extent of ETF’s use of the VITTORIO RICCI mark on the merchandise in question in prior years”); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). This factor is neutral.

VI. Conclusion

The goods are legally identical and presumed to travel in the same channels of trade to the same classes of consumers, the marks are more similar than dissimilar, and Opposer’s GEM BOX mark is not so conceptually weak as to render confusion with Applicant’s JEWEL BOX mark unlikely. Confusion is likely.¹⁴

Decision: The opposition to registration of Applicant’s mark on the ground of likelihood of confusion is sustained.

¹⁴ To the extent Applicant argues that the Examining Attorney’s decision to publish the involved application for opposition is relevant, it is mistaken. Even if Applicant’s expert witness is correct that the Examining Attorney was aware of Opposer’s pleaded marks and nevertheless published Applicant’s mark for opposition, this would be irrelevant. *McDonald’s Corp. v. McClain*, 37 USPQ2d 1274, 1277 (TTAB 1995); *Miss Universe L.P., LLLP v. Community Mktg., Inc.*, 82 USPQ2d 1562, 1571 (TTAB 2007).